

REMARKS

The Office Action mailed October 12, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Summary of Claims

Claims 29-45 and 47-64 are currently pending in the application, with claims 29, 47, 51, 52, and 59 being independent claims. Claims 1-28 and 46 are cancelled; claims 51-64 are added; and claims 29, 31-43, and 47-50 are amended, in accordance with the above amendments.

II. Summary of Rejections

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 29-30, 35-38, and 43-46 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,331,610 to Kikuchi;
- Claims 29-30, 37-39, and 43-46 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 6,101,842 to Delacretaz;
- Claims 39-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Kikuchi and U.S. Patent Application Number 2003/0121280 to So et al.;
- Claims 29-39 and 42-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent Number 4,593,842 to Koenuma, U.S. Patent Number 6,053,630 to Polansky, et al., and U.S. Patent Number 4,627,739 to Shingo, et al.;
- Claims 40-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Koenuma, Polansky, Shingo, and So;
- Claims 40-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Delacretaz and So; and
- Claims 47-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Koenuma, Polansky, Shingo, and So.

In addition, various claims were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Applicant submits that the various amendments to these claims overcome the rejection.

III. The Claims Patentably Distinguish Over The Applied Prior Art

Discussion of Independent Claims 29, 52, and 59

Independent claim 29 recites various features of a timepiece configured to be worn on a wrist of a wearer. The timepiece includes a case that defines a recess, a timing element positioned within the recess, and a band extending from at least one side of the case. The band has a first link and an adjacent second link that is joined with the first link. The first link includes a first extension element defining a connecting channel and a joining channel. The connecting channel is parallel to the joining channel, and each of the connecting channel and the joining channel extend entirely through the first extension element. A first cover member is separate from the first extension element and extends over a portion of the first extension element that has the connecting channel. The first cover member is positioned to be opposite the wrist relative to the first extension element. A connecting springbar extends through the first connecting channel to connect the first extension element to the first cover member. A joining springbar extends through the joining channel to join the first link to the second link. The second link is substantially identical to the first link and has a second extension element and a second cover member. The second cover member extends over a portion of the first extension element that has the joining channel, and the joining springbar secures the first extension element to the second cover member to join the first link to the second link. In addition, the first extension element is unsecured to the second extension element.

A first rejection of independent claim 29 states that Kikuchi anticipates independent claim 29. According to the rejection, element 34a is a cover member and element 34 is an extension element. Referring to independent claim 29, "the first cover member extends over a portion of the first extension element...[and] is positioned to be opposite the wrist relative to the first extension element." In Kikuchi, however, element 34a is positioned next to element 34 (See Figure 6). In contrast with independent claim 29, therefore, element 34a does not extend over element 34, and element 34a is not positioned to be opposite the wrist relative to element 34.

A further distinction between independent claim 29 and Kikuchi relates to the concept of a link in a wrist-worn timepiece. Independent claim 29 recites that the first link includes the first extension element and the first cover member. Accordingly, each of the first extension element and the first cover member are elements of a single link. Kikuchi, however, refers to element 34a as "link 34a" and also refers to element 34 as "link 34" (see Kikuchi, column 4, lines 22-30). That is, element 34a is one link, and element 34 is another link. The rejection, therefore, utilizes the structures of two discrete links to reject elements that are claimed as being within a single link.

A second rejection of independent claim 29 states that Delacretaz anticipates independent claim 29. According to the rejection, element 2 is a cover member and elements 3 are extension elements. Referring to independent claim 29, each of the first extension element and the second extension element are secured to the first cover member, with "the first extension element being unsecured to the second extension element." In contrast with independent claim 29, each of the elements 3 in Delacretaz are secured to each other with the pins 4. That is, pins 4 extend through apertures in two adjacent elements 3 to join elements 3 to element 4. That is, Delacretaz discloses a configuration wherein the extension elements are secured to each other. Furthermore, Delacretaz does not teach or suggest a configuration wherein the extension elements are unsecured to each other.

A third rejection states that independent claim 29 is obvious over a combination of Koenuma, Polansky, and Shingo. According to the rejection, elements 1 in Koenuma are cover members and elements 6 are extension elements. In order to connect an extension element of Koenuma with two adjacent cover members, four pins are utilized. The Examiner noted in the rejection that the broadest definition of channel does not require a through channel. Independent claim 29, however, is amended to recite the following: "each of the connecting channel and the joining channel extending entirely through the first extension element." In contrast with independent claim 29, therefore, Koenuma discloses holes that do not extend entirely through the extension element, and four pins are utilized to join the elements together. According to the rejection, Polansky is utilized for the disclosure of a springbar and Shingo is utilized for the disclosure of other watch elements.

Based upon the above discussion, the Applicant submits that independent claim 29 is allowable over the various rejections. In addition, claims 30-45, which depend from independent

claim 29, should be allowable for at least the same reasons. Furthermore, independent claims 52 and 59 and dependent claims 53-58 and 60-64 should also be allowable for the same reasons.

Discussion of Independent Claim 47

Independent claim 47 recites various features of a wrist-worn timepiece that includes a case, a timing element, a crystal, and a band. The case defines a recess, and the timing element is positioned within the recess. The crystal extends over the timing element and is formed of an at least partially transparent material. The band extends from at least one side of the case and has a plurality of links joined by springbars. In addition, the band includes a cover member with a configuration of a plate that extends over at least a portion of the crystal.

The Office Action states that independent claim 47 is obvious over a combination of Koenuma, Polansky, Shingo, and So. Independent claim 47 states that (1) the band has a plurality of links, (2) the band has a cover member extending over at least a portion of the crystal, and (3) the cover member has a configuration of a plate.

Koenuma, Polansky, and So disclose watch bands formed from individual links that may be joined to form a structure that extends around a wrist of a wearer. In contrast with Koenuma, Polansky, and So, Shingo discloses a bracelet-style watch band that is not formed from links, but is a unitary member that extends around a substantial portion of the wrist. Referring to Figures 1 and 2 of Shingo, a coil spring 3 extends around the watch band. The rejection does not address the manner of combining Koenuma, Polansky, Shingo, and So so as to arrive at the claimed invention. The Applicant assumes, however, that the Examiner intends the watch bands of Koenuma, Polansky, and So (which includes links) to be combined with the coil spring of Shingo to purportedly arrive at the claimed invention.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). A rejection must present a line of reasoning as to why an artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various concepts from the references to arrive at the claimed invention. That is, the rejection must provide a line of reasoning as to why it would be obvious to combine a linked watch band with a coil spring. The claimed invention, is clearly directed to a combination of concepts (e.g., watch

band with links and a cover member extending over a portion of the crystal). To support the conclusion that the claimed combination is directed to obvious subject matter, the references must expressly or impliedly suggest the claimed combination, or the rejection must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Even if a line of reasoning would suggest that it would be obvious to combine a linked watch band with a coil spring, none of the references teach or suggest a cover member with a configuration of a plate, as recited by independent claim 47. To establish a *prima facie* case of obviousness, the burden is upon the Examiner to demonstrate that the prior art references teach or suggest all the claim limitations. That is, all of the claim limitations must be taught or suggested by the prior art. As noted above, none of the references teach or suggest a cover member with a configuration of a plate.

Based upon the above discussion, the Applicant submits that independent claim 47 is allowable over the combination of Koenuma, Polansky, Shingo, and So. In addition, claims 48-50, which depend from independent claim 47, should be allowable for at least the same reasons.

Discussion of Independent Claim 51

Independent claim 51 recites various features of a wrist-worn timepiece that includes a case, a timing element, a crystal, and a band. The case defines a recess. The timing element is positioned within the recess, and the timing element has a visible time display. The crystal extends over the timing element and is formed of an at least partially transparent material. The band extends from at least one side of the case and has a pair of cover members that extend over edges of the crystal to define a space between the pair of the cover members. An entirety of the time display is visible through the space.

The coil spring of Shingo extends over the crystal and obscures a portion of the time display. Referring to Figure 1 of Shingo, the watch displays of time of "12:30" and the coil spring obscures the number one, a small portion of the number three, and approximately half of the number zero. Accordingly, a significant portion of the time display is obscured by the coil spring. Independent claim 51, however recites that an entirety of the time display is visible through the space between the cover members.

In another embodiment depicted in Figures 3 and 4, Shingo discloses two coil spring portions that do not extend over the time display. There is no indication, however, that the coil springs extend over edges of the crystal, as recited by independent claim 51.


Based upon the above discussion, the Applicant submits that independent claim 47 is allowable over Shingo.

IV. Conclusion

In view of the foregoing, the Applicant respectfully submits that all claims are in a condition for allowance. The Applicant respectfully requests, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on January 10, 2005. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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Dated: January 10, 2005